REMARKS/ARGUMENTS

Responsive to the Office Action mailed September 20, 2005:

I. PRIOR ART MATTERS

A. The Office Action rejected claims 1-31 under 35 USC 103(a) as being unpatentable over Freeman in view of Compton. Applicant respectfully traverses the rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.[1] If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.[2]

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.[3]

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

1. The references, even if combined, do not teach or suggest all the claim limitations.

As to claim 1, Freeman, in the sections cited by the Examiner, does not disclose steps b) through f). Specifically, Applicant can find no reference in the cited sections to any compression being performed at all, let alone any user identifying a compression scheme to be used from a group of possible compression schemes.

As to claim 1, Compton does not teach the claimed steps b), d), and e). Specifically, Compton does all source reading and compression at a central location, not the user's remote location, as claimed. See Compton cols. 3-6 and Figs. 1-3. Particularly note that Fig. 1 shows

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[1]MPEP Sec. 2142.
[2] Id.
[3]Id. (emphasis supplied)

the "Video Source" 14 as being at a different location (presumably the central location of the central processing system 16) from the end user 28. Also, see Col. 4 lines 21-29, which describe compression being done by subsystem 12, not the user's system, which is remote from central subsystem 12. This is a vital difference, as the claimed invention allows the user to capture and compress selected tracks of digital content using the user's own system, and then transmit the compressed content to a central location. The user is thus the owner of the digital media from which the selected tracks are compressed, not the central location. The user has complete control over which portion of his digital media library that he wishes to transmit to the central location for storage. This is not possible with the cited references. Furthermore, as explained at page 5 of the Specification, the user has the ability to compress any track obtained from other lawful sources. Again, this is not possible with the cited references.

Furthermore, the cited references do not disclose the capability of the user to specify only certain tracks for compression.

As to claim 2, Applicant cannot find where Compton discloses validating the source's identity against an authorization database at the central location. The Examiner has merely indicated large blocks of text without specifically pointing out the point of disclosure.

As to claim 11, Applicant cannot find where Compton discloses managing the digital content database (at a central location) from the remote location. The Examiner has merely indicated large blocks of text without specifically pointing out the point of disclosure.

Claims 2-11 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

As the Office Action rejected claims 12-31 for the same reasons as claims 1-11, claims 12-31 are also allowable.

2. There is no suggestion in the prior art to combine the references and no teaching of a reasonable expectation of success.

Neither reference contains any teaching to combine the teaching of the other reference, nor any teaching of a reasonable expectation of success if the combination were made. Applicant respectfully submits that the Examiner is using Applicant's own disclosure to find such a teaching. This is not permitted.

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

Respectfully submitted,

Dated: 14 Oct 05

By _____

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